

REMARKS

Applicant respectfully requests reconsideration of the present application.

I. Disposition of the claims

Claims 1-7 and 9-20 are pending and stand rejected.

The restriction requirement was withdrawn due to a lack of a serious burden.

II. Rejection under 35 U.S.C. § 103(a)

Claims 1, 3-10, 12, and 14-16 are rejected as obvious over Ichinohe (WO 02/03928, translated by U.S. Apn. Pub. No. 2003/0082218) in view of Yonekura (U.S. Pat. No. 4,892,726), Wada (WO 00/042112, translated by U.S. Pat. No. 6,534,044) and Roidl (EP0523911). Office action, p. 3. According to the record for this rejection, Ichinohe fails to “teach the use of polymethylsilsesquioxane as a component in [a] cosmetic composition [and fails to teach to] selectively use polymethylsilsesquioxane as a component of the composition of example 11.” Office action of 10-06-2006, p. 4; see also final Office action, p. 3-4. To remedy these deficiencies, the rejection of record uses the teachings of Yonekura, which, according to the rejection, include “the use of polymethylsilsesquioxane powders as a component of ... cosmetic compositions.” Office action of 10-06-2006, p. 4; see also final Office action, pp. 4-5. The rejection of record further applies Wada for reasons not relevant to traverse the rejection. Office action of 10-06-2006, p. 5; see also final Office action, p. 7.

In the relevant conclusion, the rejection reasoned that it “would have been obvious ... to substitute a silicone emulsion with the polyfluoroalkylmethylsiloxane, and most preferably the polymethyl-3,3,3-trifluoropropylsiloxane into the cosmetic composition because Ichinohe et al. teaches the use of fluorine-modified silicones for example fluorine-contained unctuous agent which can also be mixed include perfluoropolyether, perfluorodecaline, perfluorooctaine and the

like in the cosmetic and Roidl teaches the use of the polyfluoroalkylmethylsiloxane, and most preferably the polymethyl-3,3,3-trifluoropropylsiloxane in a cosmetic.” Office action, p. 6. This rejection is respectfully traversed.

Even if Roidl were to teach the use of the polyfluoroalkylmethylsiloxane, when the Examiner made the restriction requirement and election of species requirement dated May 2, 2007, the Examiner stated in no uncertain terms that the species of *one or more kinds of oil-soluble silicone resins selected from the group consisting of perfluoroalkyl group-containing polyalkylsiloxysilicate* are “patentably distinct species.” Office Requirement of 05-02-2007, p. 2. Thus, a generalized motivation to substitute members of the class of polyfluoroalkylmethylsiloxanes is improper.

Furthermore, even if “Roidl teaches that ... the polymethyl-3,3,3-trifluoropropylsiloxane [has] been employed instead of silicone emulsions because they eliminate the tendency of skin irritation and fluoroalkylsiloxanes have the advantage of functioning as a moisturizer and form films on the skin which act as a barrier against transepidermal water loss, with the result that the skin tends to be maintained in a softened condition,” final Office action, p. 6, that would not necessarily make Roidl’s polymethyl-3,3,3-trifluoropropylsiloxane an *oil-soluble silicone resin* as recited in claim 1. The *perfluoroalkyl group-containing polyalkylsiloxysilicate* of the present invention is an *oil-soluble silicone resin* having Q-units, i.e., $\text{Si}(\text{-O-})_4$ and terminal M units, i.e., $\text{Si}(\text{-O-})\text{R}_3$, and having a network structure. Due to such a structure, the *one or more kinds of oil-soluble silicone resins selected from the group consisting of perfluoroalkyl group-containing polyalkylsiloxysilicate* make it possible to have a superior film forming ability and make it possible to provide a cosmetic composition with superior durability.

On the other hand, Roidl’s polymethyl-3,3,3-trifluoropropylsiloxane is silicone oil having difunctional siloxane D units, i.e., $\text{Si}(\text{-R-})_2(\text{-O-})_2$ (p. 2, l. 35) and has no network structure. As a result, polymethyl-3,3,3-trifluoropropylsiloxane has a weak film-forming ability.

Applicants respectfully submit that Roidl fails to disclose a *perfluoroalkyl group-containing polyalkylsiloxysilicate*. Nor does any of the other cited references. Since silence cannot amount to a motivation to establish a prima facie case of obviousness, the present cosmetic composition is not obvious over Ichinohe in view of Yonekura, Wada, and Roidl. Thus, the rejection should be withdrawn.

Claim 2 is rejected as obvious over Ichinohe as applied in the first rejection and further in view of Fukuchi (English Translation of JP 01211518). Office action of 10-06-2006, pp. 8-9; see also Office action, pp. 8-9. The rejection does not use Fukuchi to remedy the deficiencies that were noted above. Thus, this rejection should be withdrawn too.

Claims 11 and 13 are rejected as obvious over Ichinohe as applied in the first rejection and further in view of Hayashi (English Translation of JP 2000327948). Office action of 10-06-2007, pp. 9-10; see also final Office action, pp. 9-10. The rejection does not use Hayashi to remedy the deficiencies that were noted above. Thus, this rejection should be withdrawn too.

Conclusion

The present application is believed to be in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Patent
Atty. Dkt. No. 016912-0209
Application No. 10/507,501
Response to final Office action dated August 29, 2007

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

November 29, 2007
Date _____

/Sean Allen Passino/
Sean A. Passino, Reg. # 45,943 for
By _____

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5414
Facsimile: (202) 672-5399

Richard L. Schwaab
Attorney for Applicant
Registration No. 25,479